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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,335	02/14/2002	Yvonne Watters Booth	AUS920010775US1	1983
45502	7590	06/20/2006		
DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759			EXAMINER APPIAH, CHARLES NANA	
			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/076,335	<b>Applicant(s)</b> BOOTH ET AL	
	<b>Examiner</b> Charles N. Appiah	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 11, 12, 24-27, 29, 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 7-9, 11, 21, 23-26, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Kesler (US 2002/0045437).

Regarding **claims 1, 9 and 24**, Kesler discloses a method, system and a machine-readable medium having a plurality of instructions executable by machine embodied therein wherein the plurality of instructions when executed cause the machine to perform a method for determining the location, which reads on claimed "position," of a mobile device (MD, 16), which reads on claimed "electronic device," within a communication network (see paragraph [0006], which reads on claimed "wide area network," the network comprising:

distributing a tracing software (12), which reads on claimed "tracing tool," (see paragraphs [0009 and 0015]) to a server (14), which reads on claimed "first network element," within said communication network. See paragraph [0015];

detecting the event that the said MD (16) is stolen, which reads on claimed "detecting the physical separation," from its owner. See paragraph [0016];

determining identifying indicia of the said MD (16), see paragraph [0015], wherein the said identifying indicia are automatically transmitted by the said MD (16) during communication between the said MD (16) and a call center, which reads on claimed "second network element," of the said communication network. See paragraphs [0006 and 0009];

tracing the said MD (16), see paragraph [0032], on the said communication network utilizing the tracing software, wherein the said monitoring comprises:

intercepting data, during a call, of the said communication between the said MD (16) and said call center including the said identifying indicia in response to detecting the event that the said device is stolen, which reads on claimed "physical separation". See paragraphs [0004 and 0009];

determining a location, see paragraph [0016], of the said MD (16) within said communication network in response to an interception of said identifying indicia. See paragraph [0016].

Regarding claims 2, 21 and 25, Kesler further discloses inherently distributing the tracing tool to a plurality of Internet protocol routers (network elements) within the wide area network (feature of tracing software including a server part, as well as

computers on the network having client tracing software installed, see paragraphs [0022-0023]). It is inherent that a plurality of network elements would serve as monitoring servers in order to provide a truly wide area tracing system.

Regarding claims 3 and 11, Kessler further discloses wherein determining identifying indicia of the electronic device comprises: identifying data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network, and extracting the identifying indicia from data transmitted from the electronic device prior to the physical separation (see paragraphs [0024-0026]).

Regarding claims 5 and 26, Kessler further discloses wherein determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing at least one of a host name and IP address within the data transmitted by the electronic device prior to the physical separation utilizing a portion

of the wide area network (ensuring the received system ID matches the locally stored system ID, paragraph [0026-0027]).

Regarding claim 7, Kessler further discloses the method further comprises causing data specifying the identifying indicia to be stored within a database associated with the first network element prior to the physical separation (paragraph [0024]), and determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing the database (paragraph [0026-0027]).

Regarding claim 8, Kesler further discloses the method comprising generating a notification indicating the physical separation of the electronic device for a responsible party associated with the electronic device (see paragraph [0033]).

Regarding claim 23, Kesler further discloses wherein the monitoring server is inherently distributed among a plurality of network elements within the wide area network (feature of tracing

software including a server part (computers on the network having client tracing software installed, see paragraphs [0022-0023]). It is inherent that a plurality of network elements would serve as monitoring servers in order to provide a truly wide area tracing system.

Regarding claims 29 and 30, Kesler further discloses wherein determining the physical position of the electronic device within the wide area network in response to the interception of the identifying indicia comprises: transmitting a link tracing message between the electronic device and the first network element (see paragraph [0027]), identifying a network element coupled between the electronic device and the first network element in response to a transmission of the link tracing message, and determining the physical position of the electronic device utilizing the network element coupled between the electronic device and the first network element (client software dialing a call center,

leading to unauthorized user's caller ID being recorded,  
paragraphs [0017-0019],[0023], [0033).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 4, 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kesler as applied to claims 1, 9 and 24 above, and further in view of Cotichini.

Regarding claims 4, 12, and 27, Kesler fails to explicitly teach wherein determining the identifying indicia of the electronic device comprises determining a MAC address of the electronic device.

In an analogous field of endeavor, Cotichini discloses a method for monitoring and locating an electronic device over a global network in which the indicia, which is the MAC, address of the electronic device is used in identifying the electronic device (see col. 16, lines 37-42).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Kesler's tracing system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cain et al. (5,764,892 & 6,507,914) discloses a system for



locating and monitoring electronic devices utilizing an embedded secret security system.

Solyman et al. (6,244,758) discloses an apparatus for monitoring electronic devices via a global network.

Johnson et al. (6,594,481) discloses an apparatus for detecting potentially fraudulent telecommunications.


Fleming, III (6,031,894) discloses a method for locating stolen electronic device using automatic number identification information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CA



CHARLES APPIAH  
PRIMARY EXAMINER